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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/666,152	09/20/2000	Kimiyuki Shibuya	49218-C	7703	
21874 7	590 03/31/2003				
EDWARDS & ANGELL, LLP			EXAMINER		
P.O. BOX 916 BOSTON, MA			STOCKTON, LAURA		
			ART UNIT	PAPER NUMBER	
			1626	18	
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Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office Address: COMMISSIONER OF PATENTS, AND TRADEMARKS Washington, D.C. 20231

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Responsive to communication(s) filed on	This is a communication from the examiner in charge of your application. COMMISSIONER OF PATENTS AND TRADEMARKS					
This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 D.C. 11; 453 O.G. 213. A shortened statutory period for response to this action is set to expire	OFFICE ACTION SUMMARY					
Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 D.C. 11; 453 O.G. 213. A shortened statutory period for response to this action is set to expire						
whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Disposition of Claims Claim(s)	ation is in condition for allowance except for formal matters, prosecution se to the marks in classed in					
Claim(s) 9-12 and 14-18 Of the above, claim(s) is/are withdrawn from consideration. Claim(s) 15-18 Claim(s) 9-12 and 14 Claim(s) 9-12 and 14 Claim(s) is/are objected to are subject to restriction or election requirement.	rom the mailing date of this communication. Failure to respond within the period for respond for					
Of the above, claim(s) Claim(s) 5 - 18	s					
Claim(s)is/are objected to. Claim(s)are subject to restriction or election requirement.	m(s) is/are withdrawn from consideration.					
Claim(s)are subject to restriction or election requirement.						
	are subject to restriction or election requirement.					
See the attached Notice of Draftscerson's Patent Drawing Review, PTO-948. The drawing(s) filed onis/are objected to by the Examiner. The proposed drawing correction. filed onisapproved disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.	is/are objected to by the Examiner. wing correction filed on					
Priority under 35 U.S.C. § 119	C. § 119					
Acknowledgment is made of a cla \approx for foreign priority under 35 U.S.C. § 119(a)-(d).	s made of a cla -u for foreign priority under 35 U.S.C. § 119(a)-(d).					
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been	None of the CERTIFIED copies of the priority documents have been					
received. received in Application No. (Series Code/Serial Number) received in this national stage application from the International Bureau (PCT Rule 17 2(a)).						
*Certified copies not received:	received:					
Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).						
Attachment(s)						
☐ Notice of Reference Cited, PTO-892	e Cited, PTO-892					
Information Disclosure Statement(s), PTO-1449, Paper No(s).						
Interview Summary, PTO-413						
Notice of Draftperson's Patent Drawing Review, PTO-948						
Notice of Informal Patent Application, PTQ-152						
SEE OFFICE ACTION ON THE FOLLOWING PAGES 09/6665152	-SEE OFFICE ACTION ON THE FOLLOWING PAGES- 09/666,152					

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DETAILED ACTION

Claims 9-12 and 14-18 are pending in the application.

Rejections made in the previous Office Action that do not appear below have been overcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 14 depends from a cancelled claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable Hirai et al. {JP 04-139172}. An English translation of Hirai et al. has been supplied previously.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim benzoxazole compounds. Hirai et al. teach benzoxazole compounds which are structurally similar to the instant claimed compounds. See in Hirai et al., for example, wherein R¹-R⁴ are each hydrogen, A is oxygen, R⁵ is alkyl, and R⁶ is a substituted heteroaryl group (pages 1 and 2 of the Japanese patent and pages 6 and 16 of the

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English translation). Also see, for example, compounds 5, 9, 17, 18, 34, 71, 72 and 77 in the Table on pages 7 and 8 of the Japanese patent.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds in the prior art and the compounds instantly claimed is that of positional isomerism (the instant n is 2 whereas R⁵ is methyl in the prior art and the –C(O)NHR⁶ group is attached to the fixed carbon, -CHR⁵). In other words, the instant claimed compounds, for example, have an "ethylene" group {-CH₂CH₂-} whereas the prior art teaches an "ethylidenyl" group {-CH(CH₃)-}.

Alternatively, the difference between the compounds in the prior art and the compounds instantly claimed is that Applicants are claiming a homolog of the compounds taught in the prior art (the instant n is 2 whereas R^5 is hydrogen in the prior art and the $-C(O)NHR^6$ group is attached to the fixed carbon, $-CHR^5$). In other words, the instant

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claimed compounds, for example, have an "ethylene" group $\{-CH_2CH_2-\}$ whereas the prior art teaches a "methylene" group $\{-CH_2-\}$.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by Hirai et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

Alternatively, to those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. *In re Henze*, 85 USPQ 261 (1950).

One skilled in the art would have been motivated to prepare positional isomers or homologs of the compounds in the prior art to arrive at the instant claimed compounds with the expectation of

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obtaining additional beneficial compounds that would be useful in treating ulcers. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Response to Arguments

Applicants' arguments filed January 28, 2003 have been fully considered. Applicants argue that the compounds of the present invention comprise a two carbon linker in which groups **A** (benzoxazole-Y-) and **B** (-amide-pyridyl group) are separated by two carbon atoms, e.g., A-CH₂CH₂-B in contrast to the compounds of Hirai et al. in which groups A and B are separated by a linker having only one carbon atom, e.g., A-CH(CH₃)-B. Applicants argue that isomers are different from each other in chemical and physical properties. Applicants argue that the compounds of the prior art have a different utility.

Applicants' arguments have been considered but have not been found persuasive. Applicants claim benzoxazole compounds. Hirai et al. teach benzoxazole compounds which are structurally similar to the

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instant claimed compounds. See in Hirai et al., for example, wherein R¹-R⁴ are each hydrogen, A is oxygen, R⁵ is alkyl, and R⁶ is a substituted heteroaryl group (pages 1 and 2 of the Japanese patent and pages 6 and 16 of the English translation). Also see, for example, compounds 5, 9, 17, 18, 34, 71, 72 and 77 in the Table on pages 7 and 8 of the Japanese patent.

The difference between the compounds in the prior art and the compounds instantly claimed is that of positional isomerism or homology. In other words, the instant claimed compounds, for example, have an "ethylene" group $\{-CH_2CH_2-\}$, the linker which separates groups A and B , whereas the prior art teaches an "ethylidenyl" group $\{-CH(CH_3)-\}$ or alternatively, the instant claimed compounds have an "ethylene group", the linker which separates groups A and B (e.g., A-CH₂CH₂-B), whereas the prior art teaches a "methylene group" (e.g., A-CH₂-B).

To those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because

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chemists knowing properties of one member of series would in general know what to expect in adjacent members.

The instant specification, under the heading "Best Mode For Carrying Out the Invention" {pages 12-13 (n is 1 to 15)} and the originally filed claims {e.g., claim 1, page 232 (n is 1 to 15)} support the expectation that homologs would have similar activity. The instant disclosed invention teaches that the instant compounds have ACAT inhibiting activity:

when **n** is 1 (e.g., a **methylene** linker linking the amide residue and the 2-sulfoxide-benzoxazole residue) or when **n** is 2 (e.g., an **ethylene** linker linking the amide residue and the 2-sulfoxide-benzoxazole residue).

Also, see Compound Numbers 1-10 on page 32 of the instant specification. One skilled in the art would expect homologs to have similar activity as does Applicants as shown by the n variable being defined as 1 to 15 under the heading "Best Mode For Carrying Out the Invention" and by the specific disclosed specie.

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Further, there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990). For all the reasons given above, the instant claimed invention is found obvious over Hirai et al.

Allowable Subject Matter

Claims 15-18 are allowed over the art of record.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

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this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600